

## **REMARKS**

### **Status of the Claims**

Claims 2, 4 – 6, 10 – 12, 16 – 17, and 21- 23 are currently pending. Claims 3, 7 – 9, 13 – 15, and 18 – 20 have been withdrawn. No claims are presently amended.

### **Rejection of Claims under 35 U.S.C. § 103**

Claims 2, 4 – 6, 10 – 12, 16 – 17, and 21- 23 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over the disclosure of Anderson (US Pat. No. 6,437,150) in view of Rock (US 6,022,529). Applicants respectfully traverse, and fully incorporate their previous responses, filed April 9, 2008 and December 9, 2008, herein.

In the present rejection, the Office responded to Applicant's previous arguments by alleging that "All of [Applicant's] arguments (from pages 12-14) rely on the difference between the product of the combined prior art compound and the product of the applicant's compound. What products form due to isomerization, lactonization, or photochemical rearrangement is irrelevant. This can be viewed as preamble or intended use language, both of which are not given patentable weight."

As an initial matter, Applicants note that their previous arguments were not limited to merely the differences between the product of the combined prior art compound and the product of the applicant's compound. Applicant's previous response discussed the basic differences in the properties of the presently claimed compounds (photofragmentable fragrances) with respect to both the Anderson compounds (photo-activatable) and the Rock compounds (sunscreen agents). In particular, Applicants discussed that the differences in their respective modes of operation, which are evident from their products, does not suggest the desirability of their combination to one skilled in the art. As a chemical compound and its properties are inseparable (see, *In re Papesch*, 137 USPQ 43, 51 (CCPA 1963)), it is improper to neglect to consider such properties when considering the invention as a whole. By neglecting to consider the differences between the prior art and the instant claims, and in particular, by neglecting to consider the properties of the compounds in the cited art and the instant claims, the Office has failed to consider the one of the *Graham v. John Deere Co.* factors for determining obviousness under 35 U.S.C. § 103(a) and has failed to consider the invention as a whole.

The Office continues to allege that the combination of Rock and Anderson makes the

instant claims obvious because, “The R<sup>1</sup> group of Rock could be substituted rather easily with the molecule disclosed in Anderson to achieve the same purpose as Anderson” Action, page 4. Whether or not substitution of the R<sup>1</sup> group can be done “easily”, patentability shall not be negated by the manner in which the invention was made. 35 U.S.C. § 103(a).

The Office later states that, “The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.” However, the Office still has not provided a reason that one skilled in the art would modify the compounds taught by Rock with a compound taught by Anderson or to allegedly yield the instantly claimed invention. As stated in *Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.* 492 F.3d 1350, 83 USPQ2d 1169 (Fed. Cir. 2007), emphasis added, “...in cases involving new chemical compounds, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish prima facie obviousness of a new claimed compound.”

Applicants repeat from their response filed April 9, 2008, that the Office has not provided a reason to modify a compound disclosed by Rock to be useful as a sunscreen agent, with a fragrance compound from Anderson to yield the instantly claimed photofragmentable fragrance compounds and compositions. That is, since Anderson does not teach or suggest the use of the Rock compounds in the Anderson invention (as acknowledged by the Office; see, Action, page 3, paragraph 7) and Rock does not teach or suggest that substitution of R<sup>1</sup> therein with a fragrance molecule, the Office has not provided any reason that Rock and Anderson would be combined by one skilled in the art to yield the instantly claimed invention.

Indeed, Anderson is silent with respect to photofragmentable compounds for use as the protecting group “Z” in the compounds recited therein. As noted in Applicant’s previous response, Anderson only teaches compounds which release a fragrance, and an optional optical brightener, upon ester hydrolysis or intramolecular lactonization. In particular, Anderson is silent with respect to instantly claimed benzoin compositions.

Further, Applicants note that one skilled in the art would not consider incorporation of the benzoin groups of Rock into the fragrance system of Anderson as such is designed to generate a plurality of fragrance molecules and optionally, an optical brightener, from their disclosed species. In fact, each part of the Anderson compounds, upon initiation of decomposition, can form a fragrance molecule, including group “Z” which the Office desires to

replace with the Rock benzoin compound (see, Col 4, lines 60 – 62, “In the present invention, Z is a protective group which prevents the hydroxy ester Y-H (II) from premature cyclization to an organoleptic lactone (III). At the same time, Z can generate one or more additional organoleptic compound(s).”). The only other types of groups discussed to be generated upon cleavage of the Anderson compounds are coumarins as optical brighteners (see, Col. 4, lines 26-28); neither of which apply to instantly claimed compounds or the simple benzofurans generated there from. Finally, there is nothing of record which indicates that the benzoin groups of Rock are generally used by or would be considered useful by one skilled in the art in the fragrance industry.

The Office has only cited **Applicant’s own disclosure** as a reason to make the modification of the compounds of Rock when stating, “[t]he purpose of Anderson’s invention is nearly identical to that of applicant’s and the specific structures are known in the art.” Action, page 3.

As stated in *In re Grabiak* 769 F.2d 729, 731, 226 USPQ 870, 871 (Fed. Cir. 1985), citing *In re Berge* (emphasis in original), “The mere fact that it is *possible* to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination.” In the present case, the Office has not established that the art, at the time of filing of the instant application, suggested the desirability of the combination of Rock and Anderson.

In light of the preceding deficiencies, the Office has not provided a proper *prima facie* case of obviousness of the present claims over Anderson in light of Rock, Applicants respectfully request reconsideration and withdrawal of the rejection.

### **Conclusion**

Applicants respectfully submit that all requirements of patentability have been met. Allowance of the claims and passage of the case to issue are therefore respectfully solicited. If the Examiner has any questions or comments regarding this Amendment, they are encouraged to contact the undersigned as indicated below.

Respectfully submitted,  
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